

Hearing:

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HRW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 28, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Eden Foods, Inc.

v.

Ficel Marketing Corp.

Opposition No. 107,487
to application Serial No. 75/023,876
filed on November 27, 1995

J. Timothy Hobbs and Christopher Kelly of
Wiley, Rein & Fielding for Eden Foods, Inc.

John A. Clifford of Merchant, Gould, Smith, Edell, Welter &
Schmidt, P.A. for Ficel Marketing Corp.

Before Hanak, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Ficel Marketing Corp. filed an application to register
the mark EDAN VALLEY for "canned goods, namely, canned
vegetables, canned fruit, canned seafood, soup and pork and
beans; frozen vegetables, frozen fruit; jams and marmalades"

in Class 29 and "soft drinks, carbonated flavored and unflavored bottled water and fruit juices" in Class 32.¹

Eden Foods, Inc. filed an opposition to registration of the mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act. Opposer alleges use since at least January 1967 of the name EDEN in connection with a variety of vegetable, fruit and beverage products; ownership of several registrations for the mark EDEN or variations thereof for food and beverage products;² and the

¹ Serial No. 75/023,876, filed November 27, 1995, based on a claim of ownership under Section 44(e) of Canadian Registration No. 387,694, issued August 16, 1991.

² Registration No. 1,947,286, issued January 9, 1996, for the mark EDENRICE for "soybean and rice based food beverage";

Registration No. 1,918,958, issued September 12, 1995, for the mark EDENBLEND for "soy bean and rice based food beverages";

Registration No. 1,862,634, issued November 15, 1994, for the mark EDEN for "vegetable oils, crushed tomatoes, sauerkraut, and processed canned beans" in Class 29; "pasta; pizza sauce; teas; crackers; chips; misos; and condiments, namely, mustard, sea salt, processed sesame seeds, garlic pastes, furikake, pickled beefsteak, leaf powder, bonito flakes, pickled ginger, tekka, wasabi powder, tamari, and shoyu" in Class 30; and "unprocessed grains, namely, barley, wheat and quinoa" in Class 31;

Registration No. 1,452,337, issued August 11, 1987, for the mark EDEN for "pickled plums; processed and unprocessed dried fruits; processed nuts; processed seeds; vegetable oils, namely, corn oil, olive oil, safflower oil, sesame oil; snack foods consisting of processed nuts, processed seeds and dried fruits" in Class 29; "processed grains, namely, corn meal, soy flour, chickpea flour, barley flour, wheat flour, buckwheat flour, millet flour, rice flour, rye flour; pasta, namely, wheat noodles, wheat and egg noodles, wheat and soy noodles, wheat and spinach noodles and buckwheat noodles; soy sauce; barley malt syrup for table use; vinegar; mustard; tomato based spaghetti sauce; sea salt for table use; beverage consisting of tea and herbs" in Class 30; and "unprocessed beans, namely, aduki, black turtle beans, kidney beans, great northern beans, green lentils, mung beans, navy beans, pinto beans, soy beans; unprocessed peas, namely, chickpeas, split peas; unprocessed nuts; unprocessed edible seeds; unprocessed grains, namely, barley, rice, wheat, buckwheat and millet; unprocessed corn and unpopped popcorn; unprocessed sea vegetables, namely, sea weed" in Class 31;

likelihood of confusion with applicant's use of the mark EDAN VALLEY on food and beverage products which are closely related, if not identical, to opposer's products.

Applicant, in its answer, has denied the salient allegations of the notice of opposition.³

The Record

The record consists of the file of the involved application, the trial testimony deposition, with accompanying exhibits of Michael Potter, President and sole owner of opposer, and the status and title copies of opposer's pleaded registrations and applicant's responses to opposer's Interrogatory Nos. 3, 7 and 20 and opposers' Request for Admission No. 1, made of record by means of opposer's notice of reliance. Applicant took no testimony and made no evidence of record. Only opposer filed a brief and only opposer participated in the oral hearing.

Opposer started out as a co-op in the late 1960's and since then has grown from a retail store to the wholesale and manufacturing business it carries on today. Opposer's

partial Section 8 affidavit accepted and Section 15 acknowledged (those items which Office records indicate were deleted from the original registration have been omitted);

Registration No. 1,233,768, issued April 5, 1983, for the mark EDEN and design for "flour"; partial Section 8 affidavit accepted and Section 15 affidavit acknowledged; and

Registration No. 1,440,754, issued May 26, 1987, for the mark EDENSOY for "soybean based food beverage"; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

³ Although applicant asserted the affirmative defense of failure to state a claim upon which relief could be granted, applicant has failed to pursue this defense.

deals exclusively in food products, covering a broad range of items including grains and flours, pastas, beans, sauces and vegetables in many forms. Opposer's aim has always been to provide quality foods and as a result opposer became a pioneer in developing organic food certification in the United States and at present approximately 95% of the products sold by opposer are organically certified. According to the testimony of Mr. Potter, opposer has continuously used the Eden name both as a trade name and a trademark for its food products since at least 1968.

Opposer's food products are sold nationwide in every type of food merchandising outlet, including chains such as Safeway, Whole Foods, Publix and Kroger as well as natural food stores, convenience stores and department stores. Opposer's products are also available from approximately 20 mail order sources. Opposer's retail sales figures for 1998 were 95 to 100 million dollars. Opposer advertises extensively, both in print media, including national publications such as *Eating Well*, *American Health*, and *Let's Live*, and on radio and television. Opposer is the sponsor of a weekly cooking show on PBS television and a nationally syndicated radio show. Opposer's products have also received considerable gratuitous publicity, in connection with programs or articles discussing health, dietary patterns and the like. In his testimony, Mr. Potter

introduced numerous other promotional items used by opposer, including coupons, recipe collections, and brochures.

Opposer has a trademark enforcement policy which Mr. Potter describes as "very vigorous," and has made of record a summary of several civil actions and Board proceedings initiated against other parties, with Mr. Potter's testifying that other instances of infringement have been dealt with on a more informal basis.

The Opposition

Priority is not an issue here in view of opposer's submission of status and title copies of its pleaded registrations proving ownership of valid and subsisting registrations for the marks EDEN, EDENRICE, EDENBLEND, EDENSOY and EDEN and design. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Furthermore, Mr. Potter has testified to use of the EDEN mark since as early as 1968, while applicant has introduced no evidence of use in the United States and thus is limited to the filing date of its application.

We turn to the issue of likelihood of confusion, considering those du Pont factors which are relevant under the present circumstances. See *In re E.I. du Pont de Nemours & CO.*, 478 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or

dissimilarity of the goods in connection with which the marks are being used, or are intended to be used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ 1209 (TTAB 1999) and the cases cited therein.

With respect to the marks, opposer contends that applicant's mark EDAN VALLEY is similar to opposer's EDEN mark in appearance, sound and commercial impression. Opposer argues that the words EDAN and EDEN are virtually indistinguishable and that because EDEN engenders the notion of an "ideal place," applicant's EDAN VALLEY is similar in connotation, also referring to a place. Opposer points to product labels which applicant provided during discovery as evidence that the dominant portion of applicant's mark as actually used is EDAN, since these labels show the word EDAN being used in much larger size than the word VALLEY. Thus, opposer argues, it is EDAN which creates the overall commercial impression of applicant's mark, an impression very similar to opposer's mark EDEN.

Considering the marks in their entireties, as we must, we cannot ignore the fact that applicant's mark is not just EDAN, but rather EDAN VALLEY. While EDAN may be virtually indistinguishable in terms of appearance and sound from EDEN, EDAN VALLEY clearly differs from opposer's mark EDEN. Our analysis, however, does not stop at this point. We would agree with opposer that EDEN tends to bring to mind an

"ideal place," or, in other words, the Garden of Eden. Given this connotation for opposer's mark, applicant's EDAN VALLEY comes close in general commercial impression. The much more significant factor here, however, is the manner of actual use by applicant of its mark.⁴ As stated by our principal reviewing court, when the mark in the drawing is in typed capital letters, we must not be misled by only considering the mark as such. Instead, we must try to visualize what other forms the mark might appear in, and in doing so we should look to specimens (or, in this case, product labels) as evidence of the mark as actually being used. *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971); *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585 (TTAB 1992). By looking at applicant's product labels, as shown below, we find it readily apparent that applicant is greatly emphasizing the EDAN portion of its mark, thus creating a commercial impression very similar to opposer's EDEN mark.

⁴ The sample product labels which were produced during discovery have been made of record as Exhibit I by opposer's notice of reliance. As noted earlier, applicant has registered its mark in Canada and presumably the product labels originate from use in Canada.

See also *Uncle Ben's Inc. v. Stubenberg International Inc.*, 47 USPQ2d 1310 (TTAB 1998). Accordingly, we find a high degree of similarity in the overall commercial impressions created by the respective marks.

As for the goods involved here, opposer points out that certain of the products of applicant and opposer are identical. The remaining items, opposer argues, are closely related. Opposer further argues that since the identification of goods in the application contains no restriction as to channels of trade, it must be presumed that the goods of both would travel in the same channels of trade, which might well result in the goods being sold in the same retail food outlets and being encountered by the same purchasers, thus increasing the likelihood of confusion.

From a comparison of the identifications of goods in the application and opposer's various registrations, we find it clear that there is a definite overlap of food products, particularly in the area of canned vegetables. Opposer has also introduced evidence of its present sale of apple juice under its EDEN mark, thus demonstrating an overlap with applicant's beverages. Furthermore, in view of the broad range of food and beverage items which opposer offers under its various EDEN marks, we consider the remaining products

of applicant to be goods which would reasonably be believed by consumers as originating from opposer. This belief of common origin is especially plausible because of the requisite presumption that the goods will travel in the same channels of trade and the resultant likelihood that the goods will be encountered by the same purchasers in the same retail food outlets bearing marks which we have found to be highly similar. Thus, we find the goods of the parties, if not identical, at least closely related food and beverage products.

Opposer has raised one more factor for our consideration, namely, the strength of its EDEN mark. Opposer points to the evidence which it has made of record with respect to the 30 years of use of its mark, its sales figures of up to 100 million dollars per year, its extensive advertising and promotion of its products, its aggressive policing of its mark and to the lack of any evidence of third-party use of similar marks in the food and beverage field.⁵

We agree that opposer has established that its EDEN mark is a strong mark in its field. Furthermore, we consider this strength to be such that the scope of protection afforded opposer's mark would encompass foods

⁵ Applicant's response to Interrogatory No. 20 (Exhibit H in opposer's notice of reliance) indicated no knowledge by applicant of any third-party use of similar marks in the United States.

products beyond the immediate range of goods presently offered by opposer. This would be particularly true if the food products were organically certified. Since applicant's goods as identified in its application are unrestricted as to the nature of the goods, we must presume that applicant's food products include those which are organically certified.

Accordingly, we find that opposer has fully carried the burden of proof with respect to the likelihood of confusion, based on the similarity of the respective marks, the close relationship of the food and beverage products involved and the strength of opposer's mark.

Decision: The opposition is sustained and registration is refused to applicant.

E. W. Hanak

T. J. Quinn

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board